

## REMARKS

Applicants submit this Request for Reconsideration in reply to the Office Action mailed on October 5, 2005. Claims 1, 2, and 5-25 are currently pending. Claims 1, 6, 7, 8, 16, and 17 are independent.

On pages 2-12 of the Office Action, the Examiner rejected claims 1, 2, 5-8, 10, 12, 14, and 16-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Itakura (U.S. Patent No. 6,351,745) in view of Baji et al. (U.S. Patent No. 5,027,400). On pages 12-13 of the Office Action, the Examiner rejected claims 9, 11, 13, and 15 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Itakura and Baji, and further in view of Kitsukawa et al. (U.S. Patent No. 6,282,713). Applicants respectfully traverse these rejections, for at least the reasons stated below.

### I. Independent Claims

In rejecting the independent claims under 35 U.S.C. § 103(a), the Examiner failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach each and every limitation of the claimed invention. See M.P.E.P. § 2143.03 (8th Ed. October 2005). Here, the combination of Itakura and Baji fails to disclose each and every limitation of the independent claims, and thus the rejection of claims 1, 2, 5-8, 10, 12, 14, and 16-25 in view of Itakura and Baji is improper. Kitsukawa further fails to cure the deficiencies of Itakura and Baji, and thus the rejections of claims 9, 11, 13, and 15 in view of Itakura, Baji, and Kitsukawa under 35 U.S.C. § 103(a) is also improper.

Itakura describes a system for distributing advertisements over the Internet. The system provides a display that includes a message viewer 76 having a message viewer

window 62 (presumably for advertisements), and a browser 74 having an Internet browser window 60. See col. 9, lines 14-23 and Figure 4. The system of Itakura allows a URL stored in a URL database (transmittal condition database 36) to be selected using information stored in a user database (message user database 34) and delivered to the message viewer 76. See col. 10, lines 48-58. An advertisement stored at the URL may then be sent to the message viewer window 62 (see col. 12, lines 1-14), and may contain data which represents a home page address of a store on the WWW (see col. 8, lines 1-7). A "home page" button 64 in the message viewer 76 may then be selected to open the home page in the browser 74. See col. 9, lines 14-23.

Baji discloses an image communication/bidirectional broadcast system, such as a broadcast ISDN or a cable television, for broadcasting video programs and commercials. See Abstract. Television commercials may be sent to end terminals and inserted at specific commercial insertion points according to information stored in a data base. See col. 7, lines 46-65; col. 4, lines 13-18.

In contrast to Itakura and Baji, claim 1 recites:

An information processing apparatus for delivering contents data via a network to other apparatus, comprising:

first registration means for registering general additional information regarding said contents data,

said general additional information comprising at least one of time or date of filming a video scene of said contents data, an explanation of a scene, title to background music, contents ID, general purpose additional information ID, part covered by additional information, name covered by additional information, segment number, scene number, object number, and additional information classification;

second registration means for registering individual additional information of said contents data on the basis of at least said contents data,

*wherein said individual additional information comprises overall individual additional information which is associated with the contents data as a whole, segment individual additional information which is associated*

*with one of a plurality of segments of the contents data, and scene individual additional information associated with one of a plurality of scenes in contents data;*

storage means for storing said general additional information registered by said first registration means and said individual additional information registered by said second registration means;

extraction means for extracting said general additional information and said individual additional information stored in said storage means if a delivery request for contents data is received from other apparatus,

wherein said individual additional information is extracted on the basis of user information comprising at least one of a user usage status and user usage classification;

generation means for generating individual data to be transmitted to said other apparatus from said general additional information and said individual additional information extracted by said extraction means; and

transmission means for transmitting said contents data and said individual data generated by said generation means via said network to said other apparatus, *to enable said contents data, said general additional information, and said individual additional information to be simultaneously displayed on a display screen at said other apparatus;*

*whereby contents data is delivered together with extracted general additional information and extracted individual additional information in response to a request for usage generated by said other apparatus,*

said extracted general additional information and extracted individual additional information being generated by selecting from a database of additional information according to said request.

(emphasis added).

The disclosures of Itakura and Baji, even if combined as suggested by the Examiner, fail to disclose each and every limitation of claim 1. More specifically, contrary to the Examiner's assertions, Itakura fails to disclose the apparatus as claimed in claim 1, comprising the claimed registration means, extraction means, generation means, and transmission means, and further comprising, among other things, enabling the contents data, the general additional information, and the individual additional information to be simultaneously displayed on a display screen. Itakura further fails to disclose that the contents data is delivered together with extracted general additional information and extracted individual additional information in response to a request for

usage generated by said other apparatus. Baji fails to cure either of these deficiencies. In addition, neither Itakura nor Baji disclose individual additional information comprising overall individual additional information which is associated with the contents data as a whole, segment individual additional information which is associated with one of a plurality of segments of the contents data, and scene individual additional information associated with one of a plurality of scenes in contents data.

Itakura fails to disclose the claimed “individual additional information.” The Examiner, citing col. 10 of Itakura, first interprets “individual additional information” to mean either information retrieved from a user database, such as a user’s sex, marriage status, occupation, etc., or URL information retrieved from a transmittal condition database. See page 3, lines 8-19 of the Office Action. The Examiner applies this interpretation to show that Itakura discloses the registering, storing, extracting, generating, and delivering claim features. The Examiner, citing cols. 20-22 and Figs. 29 and 33, then interprets “individual additional information” as somehow encompassing the “home page button 64” shown in Figs. 29 and 33. See page 4, line 19 – col. 5, line 6 of Office Action. The Examiner then applies this second interpretation to show that Itakura discloses enabling the individual additional information to be simultaneously displayed along with the general information and the contents data. This bifurcated claim interpretation is improper.

The home page button 64 in Figs. 29 and 33 of Itakura does not correspond to the claimed “individual additional information of said contents data.” The home page button 64 in Figs. 29 and 33 is part of the message viewer 76 and is not related to contents data that would appear in viewer window 62 or even browser window 60. The

home page button 64 is never registered, extracted, transmitted, or delivered as required by the claim language. Therefore, the home page button 64 cannot reasonably represent the claimed “individual additional information of said contents data.”

In addition, neither the user information retrieved from the user database 34, nor the URL information retrieved from the transmittal condition database 36 corresponds to the claimed “individual additional information of said contents data.” (Emphasis added). Instead, the user database information and URL information are merely used *to select* contents data. Moreover, Itakura never displays the user information from user database 34 or the URL information from transmittal condition database 36 simultaneously with the contents information and the general additional information.

The Examiner cannot rely on one interpretation of the claimed “individual additional information of said contents data” to satisfy the registration, storage, extraction, and generation means of the claim, but then use a different interpretation of the same term to satisfy the claim limitation of enabling simultaneously displaying the contents data, general additional information, and individual additional information. The Examiner must apply the same interpretation to the same claim terms throughout the claim, and failure to do so is improper.

Itakura additionally fails to disclose the claimed contents data “delivered together” with extracted general additional information and extracted individual additional information in response to a request for usage generated by said other apparatus. According to the Examiner, Itakura discloses this subject matter in Fig. 4 as discussed in col. 9, lines 13-24. Applicant respectfully disagrees. Neither Fig. 4, nor col. 9, lines 13-24 discuss delivering any of the claimed information. This cited section

might arguably disclose delivery of a home page to browser window 60 (i.e. "window 60 displays the home page") or delivery of informational materials to message viewer window 62 ("transfers information materials concerning the goods advertised in the message displayed in the message viewer window 62"), but neither of these constitute the claimed content information, general additional information, or individual additional information, even if interpreted in any of the ways submitted by the Examiner. Furthermore, none of this information is delivered together. Thus, Itakura fails to disclose contents data delivered together with extracted general additional information and extracted individual additional information in response to a request for usage generated by said other apparatus.

Neither Baji nor Kitsukawa cure the deficiencies of Itakura.

The Examiner concedes that Itakura does not disclose that the individual additional information comprises "overall individual additional information which is associated with the contents data as a whole, segment individual additional information which is associated with one of a plurality of segments of the contents data, and scene individual additional information associated with one of a plurality of scenes of contents data," as further recited in claim 1. The Examiner instead relies on Baji as disclosing this feature. See page 5, line 20 – page 6 line 20 of the Office Action. However, the Examiner's reliance on Baji is improper.

As an initial matter, Applicant traverses the Examiner's unsupported statement that "it is well known in the industry to split up television programs, whether viewed over conventional television or via Internet broadcast, up [sic] into scenes with commercials show [sic] in between." See page 6, lines 9-11 of Office Action. This is an improper

application of 35 U.S.C. § 103(a), which requires showing that each and every limitation of the claim is well-known in the prior art. Applicant disagrees that this feature is well-known, particularly with regard to network content delivery, and requests that if the claim rejections are maintained, the Examiner support this assertion with evidence as required under 35 U.S.C. § 103(a).

The rejection is further improper because it inexplicably refers to canceled claims 3 and 4 and states that Baji discloses certain features which are not claimed (i.e. splitting regular programming up and inserting commercial or advertisement scenes into it), without addressing the actual language of claim 1. Claim 1 requires “registration means for registering individual additional information of contents data,” the information comprising “overall individual additional information which is associated with the contents data as a whole, segment individual additional information which is associated with one of a plurality of segments of the contents data, and scene individual additional information associated with one of a plurality of scenes of contents data.” This feature is not taught by Itakura or Baji, and thus the Examiner has failed to establish a *prima facie* case of obviousness under Section 103(a).

Additionally, the Examiner fails to provide adequate motivation for combining the features of Bali with the communication system of Itakura. Instead, the Examiner’s statement of motivation for combining the features in Baji with the communication system of Itakura runs contrary to the teachings of the two references, and appears to have been made with improper hindsight.

On page 6 of the Office Action, the Examiner states, “it clearly would have been obvious for one skilled in the art at the time to modify the simultaneous displaying of

contents data and additional advertising information taught by Itakura by the data stream splitting techniques of Baji in order to integrate advertisements with the regularly viewed content.” This motivation runs contrary to the teaching of Itakura, which describes displaying uninterrupted advertisements (i.e. the contents data) in the message viewer 62. Thus, the Examiner has provided inadequate motivation to combine the data stream splitting techniques allegedly taught by Baji into the display taught by Itakura.

Finally, for the rejection under 35 U.S.C. § 103(a) to be proper, the claimed invention must be considered as a whole. See M.P.E.P. § 2141(II) (8th Ed. October 2005). Here, the Examiner states that it would have been obvious to “modify the simultaneous displaying of contents data and additional advertising information” taught by Itakura by the data splitting techniques of Baji, but fails to consider the “individual additional information” as it applies to the claim as a whole.

For the above reasons, a proper case of *prima facie* obviousness under 35 U.S.C. § 103(a) has not been established by the Examiner in rejecting claim 1. Therefore, Applicant requests withdrawal of the non-final rejection. Because none of the cited references disclose or render obvious Applicant’s claimed invention, Applicant asserts claim 1 is allowable.

For reasons similar to those above, independent claims 6, 7, 8, 16, and 17 are also believed to be allowable.



## **II. Dependent Claims**

Applicant further submits that claims 2, 5, 9-15, and 18-25 each depend from one of independent claims 1, 6, 7, 8, or 17 and are therefore allowable for at least the same reasons that independent claims 1, 6, 7, 8, and 17 are allowable. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited references, and therefore are also separately patentable.

In addition, in claims 18, 19, and 21-25, the Examiner failed to find any prior art disclosing the features of those claims, but instead took "Official Notice" that the limitations in each of those claims were well known in the art at the time of the invention. Applicant traverses each of these "Official Notice" statements, and requests that the Examiner support these assertions with evidence, or else allow these claims.

## **III. Conclusion**

In view of the foregoing remarks, this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of pending claims 1, 2, and 5-25.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. For example, Applicants do not necessarily agree with comments on pages 2-6 of the Office Action regarding claim interpretation, or the comments on pages 6-12 of the Office Action regarding the Section 103 rejection of certain dependent claims, or the characterization of Itakura as disclosing "user preferences" as discussed at least on page 3 of the Office Action. Unless expressly

noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and drawings in this Request for Reconsideration, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

If a telephone interview will expedite issuance of this application, the Examiner is requested to call Applicants' representative, whose name and registration number appear below, to discuss any remaining issues.

Please grant any extensions of time required to enter this Request for Reconsideration and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 3, 2006

By: Bradley Edelman  
Bradley Edelman  
Reg. No. 57,648

**Attachments:       None**